

Election of Group for Examination

Claims 1-15 are pending in this application, and subject to a Restriction Requirement under 35 USC § 121 between claims in four groups. Within Group I, election is further required between five heterologous genes that replace a function of the adenovirus E1a gene (A-E), and thirteen promoters (F-R).

Group I (claims 1-11) is hereby elected for examination on the merits. Also elected are the Y-box transactivator YB-1 (A),<sup>(1)</sup> and the tissue-specific promoter TERT (M).

Traverse of Restriction Requirement

Applicant respectfully traverses the restriction requirement between groups III to IX, between groups A to E, and between groups F to R. Applicant does not traverse the restriction requirement between groups I and II, or between either of these groups and groups III to IX together.

MPEP § 803 indicates that a restriction requirement can only be imposed when examination of all the claims would impose a serious burden. The Office has not established that a serious burden would be imposed if the three groups in the present application were examined together.

- Claim 13 is generic to all the species in claim 15 (Groups III to VIII). Whether or not the generic claim is patentable, the species can be searched together without undue burden, because they are required to perform a specified function. In fact, the Office Action shows that all the subject matter of claims III to VIII are in the same class and subclass.
- Both Claim 13 (Groups III to VIII) and Claim 14 (Group IX) are methods of killing a cell using a virus from Group I. Almost all human cancer cells (Groups III to VIII) express TERT (Group IX).
- Claim 1 is generic to all the species in groups A to E, and groups F to R. Whether or not the generic claim is patentable, the species can be searched together without undue burden, because they are required to perform a common specified function.

Reconsideration and withdrawal of the restriction requirement is respectfully requested.

Request for Rejoinder:

Claims 12-15 are method claims that depend from and incorporate the limitations of product claims 1-11. Applicant hereby requests that these claims (and all other method claims depending from product claims in the elected group) be rejoined, upon determination that the product claims are patentable, in accordance with MPEP § 821.04.

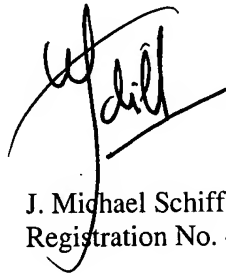
Conclusion

Applicants respectfully request that the application proceed to examination on the merits, in view of the amendment and remarks made herein.

In the event the Examiner determines that an interview would facilitate prosecution of this application, she is invited to contact applicant's representative at the telephone number indicated below.

Should the Patent Office determine that an extension of time or any other relief is required for further consideration of this application, applicant hereby petitions for such relief, and authorizes the Assistant Commissioner to charge the cost of such petitions and other fees due in connection with the filing of these papers to Deposit Account No. 07-1139, referencing the docket number indicated above.

Respectfully submitted,



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